

REMARKS

Claims 1-27 are pending in this application. By the above amendment, claim 27 has been added.

The Office Action dated June 30, 2005, has been received and reviewed. The issues raised in that Office Action were discussed with the examiner during an interview on October 12, 2004, and are addressed below. A statement of the substance of the interview is provided below.

STATEMENT OF THE SUBSTANCE OF THE INTERVIEW

A personal interview was conducted between examiner Douglas Tran and Applicant's representative, Scott Wakeman, on October 12, 2005. No exhibits were shown. Claims 1, 11 and 12 were discussed. No prior art has been applied. The operation of the claimed "correction means" was discussed. The examiner advised that claim 12 satisfied 35 U.S.C. 112, first paragraph in its present form. However, the examiner requested claims 1 and 11 be amended to show that the correction means operates based on an input. Changes to claims 1 and 11, such as the amendment to claim 1 provided above, were discussed. The examiner advised that the above amendment to claim 1 would address all issues under 35 U.S.C. 112 in connection with that claim.

ABSTRACT

The abstract of the disclosure was objected to for including more than 150 words and for including the word "means." A new abstract is provided herewith that addresses both of these issues.

REJECTION UNDER 35 U.S.C. 112, FIRST PARAGRAPH

The Office Action rejects claims 1-26 under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement because the claims are directed to subject matter that is not described in the specification in a way to enable one skilled in the art to practice the invention. For the reasons provided below, it is respectfully submitted that claims 1-26 satisfy

35 U.S.C. 112, first paragraph. The withdrawal of the rejection under 35 U.S.C. 112, first paragraph and the allowance of claims 1-26 is therefore respectfully requested.

The rejection appears to be based on the fact that the claims require “correction means for changing” a requested quantity of prints. As part of a disclosed embodiment, a human operator at a laboratory checks boxes next to screen images of certain prints to indicate that prints of those screen images are not being provided. It appears the examiner may believe that the human operator is the correction means being claimed. As discussed during the interview, the human operator who uses the disclosed system is not the claimed correction means. Instead, in one embodiment of the invention, for example, a human operator checks boxes next to certain images if prints of those images will not be provided. The claimed correction means changes the order information stored in a database based in part on the boxes checked by the operator.

At the end of the interview, the examiner agreed that claim 12 satisfied 35 U.S.C. 112. However, he advised that further rejections under 35 U.S.C. 112, first paragraph, would be raised unless claims 1 and 11 were amended to require that the correction means acted in response to an input. It is not believed that this feature needs to be recited in order to satisfy the requirements of 35 U.S.C. 112, first or second paragraph. However, to advance the prosecution of this application, a reference to an input has been added to claim 1.

The examiner also requested that a similar limitation be added to claim 11. However, after careful consideration, it is believed that claim 11 in its present form fully and clearly describes the invention. Among other limitations, claim 11 requires “correction means for changing the requested quantity of the prints in the order information stored in the laboratory database to an actual quantity of the prints to be provided to the user when the actual quantity of the prints is to be different from the requested quantity specified in the order information so that a bill describing a fee corresponding not to the requested quantity but to the actual quantity can be generated thereby.” It is believed that this description is fully supported by the specification and makes the nature of the invention clear, and that therefore claim 11 in its current form satisfies the requirements of 35 U.S.C. 112.

If the examiner makes a further rejection of claim 11 under 35 U.S.C. 112, first or second paragraph, it is respectfully requested that the examiner explain in greater detail why this claim

does not satisfy the requirements of 35 U.S.C. 112 in view of the fact that the claimed correction means is described throughout the specification, and in particular, at page 13, lines 22-24 and at page 14, lines 2-4.

New claim 27 is substantially the same as the amended version of claim 11 discussed during the interview. The examiner agreed that such an amended claim 11 would satisfy 35 U.S.C. 112. Therefore, even if claim 11 is rejected, it is believed that, based on the discussion during the interview, no grounds exist for rejecting claim 27 under 35 U.S.C. 112.

CONCLUSION

Each issue raised in the Office Action dated June 30, 2005, has been addressed, and it is believed that claims 1-27 are in condition for allowance. Wherefore, reconsideration and allowance of claims 1-27 is earnestly solicited.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

Dated: October 28, 2005

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